

III. REMARKS

As an initial matter, the Applicants respectfully note that the application was filed with 59, not 57, claims. The claims were, however, inadvertently mis-numbered to contain two sets of claims 44 and 45.

Upon entry of this Amendment, claims 2, 6 to 8, 12 to 14, 19 to 21, 24 to 28, and 32 to 38 will be pending. Claims 1, 3 to 5, 9 to 11, 15 to 18, 22, 23, 29 to 31, and 39 to 59 are canceled without prejudice to, or disclaimer of, the underlying subject matter. Claims 2, 7, 12, 19, 24, 26 to 28, and 32 to 37 are amended. Support for the claim amendments may be found in the specification as filed. *See, for example*, page 3, lines 17 to 26. Therefore, no new matter is added.

In the Office Action dated May 1, 2006, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I: Claims 1 to 17, 19 to 21 and 24 to 52, drawn to a first nucleic acid molecule, a second nucleic acid molecule, a transformed cell comprising a promoter region, a collection of non-identical oligonucleotides, and a primer pair, classified in class 536, subclass 23.1, class 435, subclass 419, class 435, subclass 287.2, and class 536, subclass 24.3, respectively;

Group II: Claim 18, drawn to a polypeptide, classified in class 530, subclass 300;

Group III: Claims 22 to 23, drawn to a computer readable medium, classified in class 711, subclass 100; and

Group IV: Claims 53 to 57, drawn to a method for determining gene expression comprising collecting mRNA, producing labeled nucleic acid molecule, and contacting

labeled nucleic acid molecule to a collection of nucleic acid molecules, classified in class 435, subclass 6.

Office Action at page 2.

The Examiner goes on to state that

Applicant is required to further elect for Group I: a specific sequence for the first purified nucleic acid molecule from SEQ ID Nos. 81307-195836, a specific sequence for the second purified nucleic acid molecule from SEQ ID Nos. 1-81306 and a specific gene sequence from SEQ ID No. 81307-195836, with regard to the transformed cell a specific promoter region for the transformed cell from SEQ ID No. 138061-195836, with regard to the collection of nucleic acids the applicant must pick either a specific nucleic acid sequence or a specific combination of nucleic acid sequences from SEQ ID No. 38061 [*sic*]-195836, with regard to the primer pair applicants must pick a specific primer pair sequence from SEQ ID No. 138061-195836. For Group II applicant must elect a specific sequence from the group of SEQ ID No. 138061-195836. For Group III, applicant must elect either a specific sequence or a specific combination of sequences from SEQ ID No. 138061-195836. For Group IV applicant must elect a specific sequence or specific combination of sequences from SEQ ID No. 138061-195836. These further restrictions are NOT election of species.

Id. at page 6.

The Applicants respectfully reiterate their traversal of the restriction requirement and the single sequence requirement and provisionally elect the subject matter of:

Group I, originally presented in claims 1 to 17, 19 to 21 and 24 to 52, drawn to a first nucleic acid molecule, a second nucleic acid molecule, a transformed cell comprising a promoter region, a collection of non-identical oligonucleotides, and a primer pair, currently presented in claims 2, 6 to 8, 12 to 14, 19 to 21, 24 to 28, and 32 to 38.

In addition, in response to the Examiner's requirement for election of a specific sequence, the Applicants further elect the single nucleic acid sequence of SEQ ID NO: 5272 for further prosecution.

The Applicants submit that the U.S. Patent and Trademark Office has not proven that the search and examination of the entire application would impose an undue burden. The Applicants submit that the complete examination would be handled most expeditiously by treating all of the pending claims as a single entity. As M.P.E.P. § 803 directs, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." The Applicants respectfully submit that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. Rather, a serious burden would arise if the application were restricted.

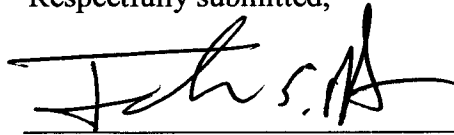
The Applicants submit that the restriction requirement is improper and contend that, at least, Groups I and II should be examined together because they are related as nucleic acids and proteins encoded by such nucleic acids. No serious burden is created for the Examiner by running a simultaneous computerized search of the polynucleotides of Group I and the polypeptides of Group II. The single search may be run in conjunction with databases such as those available at <http://www.ncbi.nlm.nih>. A single search for a particular nucleotide sequence and its translation product, for example, would automatically yield results from Groups I and II without any undue burden on the Examiner.

The Applicants further submit that restriction to a single sequence is improper and direct the Examiner's attention to M.P.E.P. § 803.04 which states that "(i)t has been determined that normally ten sequences constitute a reasonable number for examination purposes" and "up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction." Therefore, the Applicants believe that no serious burden would result by the search and examination of at least ten nucleotide sequences.

III. CONCLUSION

In view of the foregoing amendments and remarks, the Applicants respectfully submit that the present application is now in condition for allowance, and respectfully request notice of such. The Examiner is encouraged to contact the undersigned at 202-942-5085 if any additional information is necessary for allowance.

Respectfully submitted,



Date: December 14, 2006

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